



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,867	02/04/2004	Sally Judith Weine Ramsey		3758

21971 7590 05/23/2005

WILSON SONSINI GOODRICH & ROSATI
650 PAGE MILL ROAD
PALO ALTO, CA 943041050

EXAMINER

PARKER, FREDERICK JOHN

ART UNIT	PAPER NUMBER
----------	--------------

1762

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/771,867

Applicant(s)

WEINE RAMSEY, SALLY JUDITH

Examiner

Frederick J. Parker

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/8/04

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

The abstract should not be a copy of the original claim but rather follow the above guidelines.

2. The abstract of the disclosure is objected to because "Disclosur" is a mis-spelling.

Correction is required. See MPEP § 608.01(b).

3. The disclosure is objected to because of the following informalities: (1) pages are not numbered. (2) under "Brief Summary...", capitalized "To" in the middle of sentences is improper; further, it is unclear how the coatings "eliminate the need for air pollution control technology". (3) the meaning of the abbreviation "HVLP" should be written out at least once (4)

Art Unit: 1762

Under “Detailed Description...Embodiments”, paragraph 3, it is unclear what is meant by “properly formulated” and “appropriate frequencies” since neither conditions, criteria, nor examples are provided; further “mercury” beginning the second to last sentence should be capitalized. (4) Under “Detailed Description...Embodiments”, paragraph 4, it is unclear what is meant by “necessary” corrosion resistance since the conditions of corrosion are not provided. (5) Brief Description of the Drawings should be in a list format (rather than narrative) to conform with USPTO practice. See accompanying patents. Appropriate correction is required.

Claim Objections

4. Claim 1 is objected to because of the following informalities: In the claims, (1) **each claim must be written as a single sentence, ending with a period**, preferably without numbering of steps (lettering preferred). (2) between steps or listed limitations, commas or other appropriate punctuation (but not periods) should be used. (3) steps 1-3 should begin with “preparing”, “applying” and “curing” to provide positive steps. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which

Art Unit: 1762

it is most nearly connected, to make and/or use the invention. The specification is non-enabled because it provides insufficient description for one of ordinary skill to carry out the method without undue and unreasonable experimentation, In re Wands 8 USPQ 2d 1400. Evidence of undue experimentation are (1) lack of guidance or criteria regarding useful coating formulations (2) no working examples (3) the virtually infinite number of permutations of formulations of oligomers, monomers, pigments, and photoinitiators, coupled with the need for determination of workable "arrays" of UV frequencies. Phrases like "properly formulated" coating (composition), "appropriate frequencies of light", or "proper choice" do not constitute suitable criteria for enabling one skilled in the art to carry out the invention, and (4) the level of predictability and skill within the powder coating arts is such that the skilled artisan would be unable to ascertain what are workable formulation by other than undue experimentation.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 1 is rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the method must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device or method. **The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.**

Art Unit: 1762

9. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 1 is vague and indefinite because in step 1, it is unclear to what type of corrosion the coating is resistant; in steps 1,2, it is unclear how to prepare a **coating** rather than a coating formulation, and further it is unclear how the coating of steps 1-2 and 3 are related; in step 2, the phrase "or by other means" is vague and indefinite, and its scope not ascertainable, because the intended means are unclear, undefined, and not apparent to one skilled in the art; in step 3, "opaque pigment", "substrate", and "necessary array" lack antecedent basis; in step 4, the criteria which make the parts "ready to handle or ship" are unclear, and further it is unclear if it refers to the parts of step 2 or the coated parts of step 3.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following are deemed pertinent prior art, US 6001427 discloses UV curable powder coatings used for underhood vehicle parts; US 6337108 teaches powder coating compositions comprising monomers & oligomers applied electrostatically onto engine blocks (located conventionally under the hood of vehicles), etc.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

Art Unit: 1762

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Frederick J. Parker
Primary Examiner
Art Unit 1762

fjp